

REMARKS

In response to the Office Action dated January 19, 2011, reissue claims 11-47, 51-54 and 56-62 are being canceled, without prejudice to Applicants' right to pursue the subject matter of those claims in a divisional reissue application. Reissue claims 48-50 and 55 were previously canceled. Accordingly, the currently pending claims are original patented claims 1-10.

In the Office Action, all previously pending claims, including both the original patented claims and the claims being added by reissue, were grouped in a single ground of rejection under 35 U.S.C. §251. Specifically, the claims were rejected on the grounds that they are considered to be "an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present invention is based." In setting forth the basis for the rejection, page 3 of the Office Action states:

All independent reissue claims 1, 7, 8 ... contain recapture issues whereby said claims fail to contain subject matter surrendered in the original application. Claim language similar to "wherein said level difference serves to avoid capillary flow of solder to prevent short-circuiting between the leads adjacent to each other" appears in every patented independent claim. Applicant in the amendment filed 6-15-1999 presented arguments relative to the level difference allowing a clearance so to avoid the capillary flow of solder which caused short circuiting as an essential feature regarding the patentability of this invention and whereby this feature was therefore added to obtain allowance of the original patent. This feature appears relates to subject matter previously surrendered in the original application and must be included in the reissue claims.

It is not apparent from the Office Action how this rejection applies to original patented claims, because the feature that the Office Action alleges must be included in the claims does, in fact, appear in each of the independent patented claims, i.e. claims 1, 3, 4, 5, 7 and 8. For instance, claim 1 recites "wherein said level difference

serves to avoid capillary flow of solder to prevent short-circuiting between the leads adjacent to each other." Each of the other independent claims also contains a recitation directed to the avoidance of capillary flow of solder.

The Office Action does not identify any "surrendered" subject matter that is allegedly being recaptured by the original patented claims. Since they are the same claims that were allowed and issued in the original patent, they cannot now present a recapture issue. Specifically, they are no broader than the original patented claims, and therefore cannot be construed to "capture" subject matter beyond the scope of the patented claims. Withdrawal of the rejection of claims 1-10 on this basis is respectfully requested.

The Office Action, at page 4, also requires the submission of a supplemental reissue declaration signed by the applicants, citing MPEP 1414.01. However, Applicants had deferred the filing of a supplemental reissue declaration until an indication of allowable subject matter was received, pursuant to MPEP 1444. This section of the Manual states:

Once the reissue oath/declaration is found to comply with 37 CFR 1.175(a), it is not required, nor is it suggested, that a new reissue oath/declaration be submitted together with each new amendment and correction of error in the patent. During the prosecution of a reissue application, amendments are often made and additional errors in the patent are corrected. A supplemental oath/declaration need not be submitted with each amendment and additional correction. Rather, it is suggested that the reissue applicant wait until the case is in condition for allowance, and then submit a cumulative supplemental reissue oath/declaration pursuant to 37 CFR 1.175(b)(1).
(emphasis in original).

In the first Office Action dated August 29, 2003, the originally filed declaration was asserted to be defective under 37 CFR 1.175. In the response filed November 28, 2003, a Supplemental Declaration was filed.

The objection to the declaration was not repeated in the next Office Action dated March 13, 2007, nor in the final Office Action dated April 7, 2008.

Thus, the record reflects that the reissue declaration was found to comply with 37 CFR 1.175 (a) upon submission of the Supplemental Declaration on November 28, 2003. Since that time, Applicants have been following the explicit suggestion of the PTO, as set forth in the above-quoted section of the MPEP, and awaiting an indication of allowable subject matter before submitting a supplemental reissue declaration.

Nevertheless, to avoid further delays, a Supplemental Reissue Declaration signed by the inventors is being submitted herewith.

In view of the foregoing, it is respectfully submitted that both of the grounds of rejection under 35 U.S.C. §251 have been addressed and overcome or otherwise rendered moot. The application is submitted to be in condition for allowance, and a notice to that effect is respectfully solicited.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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By: /James A. LaBarre/
James A. LaBarre
Registration No. 28632

Customer No. 21839
703 836 6620